

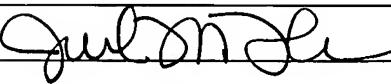


Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | |
|--|----------------------|--------------------------|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) |
| | | TWAR.002A/TWC 03-18 |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>March 24, 2010</u> Signature  | Application Number | Filed |
| | 10/723,959 | November 24, 2003 |
| Typed or printed <u>Julie M. Flores</u> name _____ | First Named Inventor | |
| | Patrick Ladd, et al. | |
| Art Unit 2194 | Examiner | |
| | Anya, Charles E. | |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

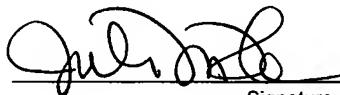
The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.
 assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
 attorney or agent of record.
Registration number 58,559

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Julie M. Flores

Typed or printed name

858-675-1670

Telephone number

March 24, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

| |
|---|
| <input type="checkbox"/> *Total of _____ forms are submitted. |
|---|

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant
Examiner
Date:

For:

Patrick Ladd, et al.
Anya, Charles E.
November 24, 2003App. No.: 10/723,959
Gr. Art Unit: 2194**METHODS AND APPARATUS FOR HARDWARE REGISTRATION IN A NETWORK DEVICE****PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir or Madam:

In response to the Office Action dated November 24, 2009 ("Office Action"), herein requests a pre-appeal brief review of the above-identified application as follows:

I. CLEAR ERROR IN ASSERTING PETERKA '534 DISCLOSES DISCOVERING AT LEAST ONE API USING AT LEAST ONE APPLICATION

Per pages 5, 14, and 29 of the Office Action, the Examiner contends with respect to independent Claims 30, 12, and 43 that Peterka, et al. (U.S. Patent No. 7,487,534; hereinafter referred to as "Peterka '534") discloses "discovering said at least one hardware registry and said software interface with said software application ("...an application can learn what types of resources are available..." Col. 2 Ln. 52-60, "...download application must go to learn about existing resources..." Col. 4 Ln. 23-25, Col. 6, Ln 1-8)." {emphasis added} Applicant respectfully submits that the Examiner's contention constitutes a clear error.

Peterka '534 does not disclose discovering software interfaces with a software application. Rather, at col. 2, lines 52-60 Peterka '534 discloses that the "*ResourceRegistry is a convenient place where an application can learn what types of resources are available*" {emphasis added}; at col. 4, lines 23-25 Peterka '534 indicates that the "*ResourceRegistry is the single place where a downloaded application must go to learn about existing resources*" {emphasis added}; and at col. 6, lines 1-8 Peterka '534 states "*a downloadable application may ask the ResourceRegistry what types of resources are available on the terminal*" {emphasis added}. Hence, Peterka '534 merely discloses an application learning what types of resources are available by going to the Resource Registry, and does not in any way disclose the application discovering the *software interfaces themselves*.

Applicant further notes that it is the software interface (e.g., API) in Peterka '534 which is used to discover the hardware registry. For example, at col. 3, lines 41-45 Peterka '534 indicates that "*the present invention relates to an application programming interface (API) that provides a uniform mechanism for gaining access to resources (ResourceRegistry), managing multiple resources of the same type (ResourceTypeManager) and accessing the individual resource's management state and status (GenericResource and ObjectState)*." {emphasis added}. In other words, Peterka '534 discloses a single, uniform API which is used to (i) determine the available resources (by accessing the *ResourceRegistry*), and (ii) manage these resources (via the *ResourceTypeManager*). In contrast, the invention of Claims 12, 30, 34 and 43 provide a plurality of data or entries relating to at least one hardware feature, and a plurality of API that can be used to access and control the at least one hardware feature. The software application in 12, 30, 34 and 43 enables discovery of the at least one hardware feature and the API which will be used to access it. There is no need in Peterka '534 to provide the ability of the API to discover other APIs, because it is the same API which accesses the *ResourceRegistry* as that which subsequently utilizes the resources.

Accordingly, Applicant respectfully submits that the Examiner's position that Peterka '534 discloses discovering at least one API using at least one application constitutes a clear error.

Application No. : 10/723,959
Filed : November 24, 2003

II. CLEAR ERROR IN FAILING TO PROVIDE CITATION AS TO WHERE PETERKA '534 OR PETERKA '183 DISCLOSES DISCOVERING A SOFTWARE INTERFACE USING AT LEAST ONE APPLICATION

With respect to independent Claim 34, on pages 27-28 of the Office Action, the Examiner also asserts that the Claim is rendered obvious given Peterka '534 and Peterka (U.S. Patent No. 6,948,183; hereinafter referred to as "Peterka '183"). At page 27, the Examiner merely asserts that Peterka '534 discloses "*discovering said at least one hardware registry using said at least software application* ("...and application can learn what types of resources are available..." Col. 2 Ln. 54-56, Col. 23-25, Col. 6 Ln. 1-8)." {emphasis added}, yet failed to provide citation to where either reference teaches or suggests discovering said software interface using at least said software application, as recited in Claim 34. Such failure is, in and of itself, clearly erroneous.

Further, even if one were to assume the Examiner may, with respect to this limitation of Claim 34, repeat the arguments given for independent Claims 30 and 12 (cited above), Applicant submits that such an argument would also constitute clear error.

III. CLEAR ERROR IN FAILING TO PROVIDE CITATION AS TO WHERE IT IS BELIEVED SWEATT DISCLOSES DISCOVERING AT LEAST ONE API USING AT LEAST ONE APPLICATION

Per pages 5 and 14 of the Office Action, the Examiner contends with respect to independent Claims 1, 8, and 22 that Sweatt, et al. (U.S. Patent Publication No. 2002/0038358; hereinafter referred to as "Sweatt") discloses "discovering said at least one hardware option and said at least one API using said application (First Module 132 page 12 paragraphs 0131/0132/0133)." {emphasis added} Applicant respectfully submits that the Examiner's contention constitutes a clear error.

In support of his argument, on pages 37-38 of the Office Action, the Examiner argues that the registration and verification functionality discussed in Sweatt are "*functionally equivalent to the claimed discovery of hardware options*" and that Sweatt "*disclose an API for accessing the hardware option in the hardware registry*" because the Module 132 accesses the *BereklyDB* file to search for registered DVR. Assuming *arguendo* the Examiner's argument is correct, the Examiner has provided no citation as to where Sweatt is purported to disclose discovering at least one API using the application; that is, the Examiner has only provided citation for discovery of at least one hardware option. Applicant submits that Sweatt does not disclose the aforementioned limitation. Specifically, although various API are given in Sweatt (see e.g., paragraph [0108], nowhere does Sweatt disclose the application (e.g., Module 132) discovering at least one hardware option (e.g., DVR) and also discovering at least one API. Rather the module 132 is merely given for "*providing the functionality of verifying whether the DVR 37 is properly registered to interoperate with the systems 10A and 10B*" (see e.g., paragraph [0132]).

Therefore, not only has the Examiner failed to provide citation to where the limitation is believed to be taught, but Sweatt does not teach or suggest discovering at least one API using the application. Accordingly, Applicant respectfully submits that the Examiner's position that constitutes a clear error.

IV. CLEAR ERROR IN ASSERTING PETERKA '534 DISCLOSES RECORDS PROVIDING AT LEAST INFORMATION REGARDING ONE OR MORE API THAT CAN BE USED TO ACCESS AND MANIPULATE AT LEAST ONE HARDWARE FEATURE

Per pages 4, 5, 15-16, and 19 of the Office Action, the Examiner contends with respect to independent Claims 26, 30, 41, and 13, that Peterka '534 discloses "*detect and access records* ("...resources...") within a

Application No. : 10/723,959
Filed : November 24, 2003

hardware registry disposed on a client device ("...ResourceRegistry..." Col. 2 Ln. 55-60, Col. 3 Ln. 41-45, ResourceRegistry 100 Col. 4 Ln. 22-25, Col. 6 Ln. 1-8), said records providing at least information regarding:...one or more application programming interface (API) that can be used to access and manipulate said at least one hardware feature ("...API..." Col. 2 Ln. 46-51, Col. 3 Ln. 41-46, Col. 6 Ln. 1-8)." Applicant respectfully submits that the Examiner's contention constitutes a clear error.

Applicant submits that Peterka '534 does not disclose records providing at least information regarding one or more APIs that can be used to access and manipulate at least one hardware feature. Rather, in Peterka '534, the *ResourceRegistry* merely provides information regarding the available resources (see e.g., col. 2, lines 55-60). Peterka '534 does not in any way disclose the *ResourceRegistry* as also providing information regarding any APIs for accessing, manipulating or otherwise using the available resources.

Further, per col. 3, lines 41-45, Peterka '534 discloses that it is the same API which is used in to determine the available resources (by accessing the *ResourceRegistry*) that is used to access and manage these resources. Hence, there is simply no need in Peterka '534 to provide information in the *ResourceRegistry* regarding API which may be used to access the resources because the very same API which accesses the *ResourceRegistry* utilizes the resources.

Therefore, the Examiner has respectfully committed clear error in asserting Peterka '534 discloses the above-described limitation.

V. CLEAR ERROR IN ASSERTING PETERKA '534 OR PETERKA '183 DISCLOSES A HARDWARE REGISTRY HAVING A DVR FUNCTIONALITY RECORD IDENTIFYING AN API FOR INTERFACE WITH THE DVR FUNCTIONALITY

With respect to independent Claim 43, on pages 29-30 of the Office Action, the Examiner asserts that Claim 43 is rendered obvious given Peterka '534 in view of Peterka '183. At page 29, the Examiner merely asserts that Peterka '534 discloses "*a method of operating a consumer premises device ("...terminal..." having middleware (ResourceTypeManager 120), and a hard drive in data communication with said middleware ("...computer readable medium..."").*" However, the Examiner has failed to provide citation to where either reference teaches or suggests a hardware registry having a DVR functionality record identifying an API for interface with the DVR functionality, as recited in Claim 43. Such failure is, in and of itself, clearly erroneous.

Further, even if one were to assume the Examiner may, with respect to this limitation of Claim 43, repeat the arguments given for independent Claims 26, 30, 41 and 13 (cited above), Applicant submits that such an argument would also constitute clear error.

VI. CLEAR ERROR IN ASSERTING PETERKA '534 DISCLOSES CONTROLLING HARDWARE USING THE SOFTWARE APPLICATION AND THE AT LEAST ONE SOFTWARE INTERFACE

Per page 28 of the Office Action, the Examiner contends with respect to independent Claim 43 that Peterka '534 discloses "*responsive to said discovering, controlling said DVR hardware using said at least application and said at least one software interface ("...an application can determine how many, and which, resources are available, and possibly access/use one or more of the available resources..." Col. 2 Ln. 57-60).*" Applicant respectfully submits that the Examiner's contention constitutes a clear error.

Applicant submits that Peterka '534 does not teach or suggest the aforementioned limitation. Rather, at col. 2, lines 57-60 Peterka '534 merely discloses discovery of one or more resources using an API and subsequently utilizing the discovered resources using the same API. Per col. 3, lines 41-45 Peterka '534 is

Application No. : 10/723,959
Filed : November 24, 2003

specifically aimed at providing “*an application programming interface (API) that provides a uniform mechanism for gaining access to resources (ResourceRegistry), managing multiple resources of the same type (ResourceTypeManager) and accessing the individual resource's management state and status (GenericResource and ObjectState).*” {emphasis added}. Hence, control of the hardware in Peterka '534 is provided using only the uniform API, and does not require at least one application and at least one API as is recited in Claim 43.

Therefore, Applicant submits that the Examiner's contention that Peterka '534 discloses controlling hardware using the software application and the at least one software interface is clearly erroneous.

VII. CLEAR ERROR IN ASSERTING THAT ASAIZU DISCLOSES A SINGLETON MADE PART OF MIDDLEWARE RESIDENT ON THE CPE AND BEING INSTALLED ON THE CPE AFTER INSTALLATION THEREOF IN A CONSUMER PREMISES

Per page 33 of the Office Action, the Examiner asserts that Asazu (U.S. Patent Publication No. 2001/0049691; hereinafter referred to as “Asazu”) discloses “*registry comprising a singleton made part of middleware resident on said CPE and being installed on said CPE after installation thereof in a consumer premises (“...middleware...” page 1 paragraphs 0016/0017, page 4 paragraphs 0056-0059).*” Applicant respectfully submits that the Examiner's assertion constitutes a clear error.

Asazu does not teach or suggest a singleton made part of middleware resident on the CPE and being installed on the CPE after installation thereof in a consumer premises. Rather, at paragraphs [0056-0059], Asazu merely discloses a middleware having a media data database package installed on the CPE. Even if one assumes *arguendo* that the media data database package comprises a singleton (a point which Applicant does not necessarily concede), nowhere does Asazu disclose the singleton being installed on the CPE after installation of the CPE in the consumer premises. Instead, Asazu states at paragraph [0024] that “*The computer program of middleware according to the above embodiment of the present invention permits dynamic incorporation of meta-data, unified management of meta-data through conversion of the meta-data obtained from various sources into a format interpretable by the middleware and also installation of new algorithm/format, even if would be developed in future, without the need for changes of the middleware/system.*” {emphasis added} Hence, Asazu specifically provides for middleware which is not changed or modified after installation.

Accordingly, Applicant respectfully submits that the Examiner's position that Asazu discloses a singleton made part of the middleware resident on the CPE and being installed on the CPE after installation thereof in a consumer premises, constitutes a clear error.

VIII. CLEAR ERROR IN ASSERTING PETERKA '534 DISCLOSES THE DEVICE NOT ASSOCIATED WITH THE CABLE NETWORK

Per pages 29-30 of the Office Action, with respect to independent Claim 43, the Examiner asserts that Peterka '534 discloses “*wherein said consumer premises device comprises a device not associated with said cable network, and said act of controlling is performed substantially by said cable network-provided application (“...downloadable applications...” Col. 3 Ln. 46-48, Col. 4 Ln. 23-35, Col. 6 Ln. 1-8: NOTE: the downloadable applications are downloaded over a cable network to a receiver or set-top box that is not part of cable network).*” Applicant respectfully submits that the Examiner's assertion constitutes a clear error.

Even if one were to assume *arguendo* that Peterka '534 discloses downloadable application downloaded over a cable network, nowhere does Peterka '534 teach or suggest these being downloaded to a device not associated with the cable network. The Examiner has respectfully failed to provide an indication as to where the reference teaches or suggests a device not a part of the cable network; the Examiner merely argues that it is

Application No. : 10/723,959
Filed : November 24, 2003

“discussed”, without providing adequate basis for this argument. Peterka ‘534 does not, that Applicant can find, teach or suggest the device *not* being associated with the cable network.

Therefore, Applicant respectfully submits that the Examiner’s position is not properly supported by the teachings of the reference and is thus clearly erroneous.

IX. CONCLUSION

In sum, Applicant has presented herein several distinct reasons why Applicant believes the Examiner has committed clear and reversible error in at least the rejection of Claims 1, 8, 12, 13, 22, 26, 30, 34, 38, 41, and 43. Applicant therefore respectfully requests that the present application be passed to allowance, or alternatively prosecution be re-opened with respect to the above-identified application.

Respectfully submitted,

GAZDZINSKI & ASSOCIATES, PC

Dated: March 24, 2010

By:



Julie M. Flores

Registration No. 58,559

Attorney of Record

16644 West Bernardo Drive, Suite 201

San Diego, CA 92127

Telephone No.: (858) 675-1670

Facsimile No.: (858) 675-1674